



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Enron
9-24-03
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25/
REPLY
BRIEF

Application of: D. Przytulla

Art Unit: 3727

Application No.: 09/525,002

Confirmation No.: 8191

Filed: March 14, 2000

Examiner: S. Castellano

For: LIDDED BARREL

Attorney Docket No.: 2511-091

REPLY BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents

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Sir:

Pursuant to the provisions of 37 C.F.R. § 1.193(b), Appellant submits herewith a Reply Brief in Response to the Examiner's Answer mailed July 14, 2003. A Request for Oral Argument is being submitted concurrently herewith, as a separate paper, with provision for the required fee.

RESPONSE TO EXAMINER'S ARGUMENTS

A. The Examiner's Answer Does Not Appear to be
Consistent With 37 CFR § 1.104 and/or 37 CFR § 1.193(a)(2).

The Examiner's Answer presents arguments with respect to patentability that do not appear to be consistent with the complete examination required by 37 CFR § 1.104. Also, the Examiner appears to introduce new grounds of rejection impermissible under the rules for preparation of an Examiner's Answer in 37 CFR § 1.193(a)(2). In particular, attached to the Examiner's Answer are color coded Figs. 1-3. Color coded Figs. 1 and 2 are referenced in the Examiner's discussion of the Fehres '962 patent, while color coded Fig. 3 is referenced in the Examiner's discussion of the Hammes '934 patent. As understood, Appellant believes that the color coding of each of these figures is inconsistent with the color coding of the figures previously advanced by the Examiner during prosecution. Moreover, during prosecution, Appellant believes that the Examiner previously abandoned use of the color coded figures to allegedly demonstrate lack of patentability.

The Examiner stopped color coding of the figures in response to counsel's objection to color coding as action which is improper and underhanded and generally action unbecoming of an examiner.

The Examiner's use of color coded figures during prosecution of the present application is summarized as follows:

- (1) In a non-final Office Action dated September 15, 2000, the Examiner provided a color-coded copy of Fig. 3 of the Fehres '962 patent apparently to support a § 102 rejection.
- (2) In a final Office Action dated April 5, 2001, the Examiner used a new color-coded copy of Fig. 3 of the Fehres '962 patent and a new color coded copy of Fig. 1 of the Hammes '934 patent allegedly to support § 102 rejections.
- (3) In a non-final Office Action dated September 25, 2001 (following submission of a Request for Continued Examination), the Examiner stated on page 4 that "Fehres is not being applied as previously stated and discard the colored representations of Fig. 3 of Fehres." The Examiner also stated on page 5 that "Hammes is not being applied as previously stated and discard the colored representations of Fig. 1 of Hammes."
- (4) In an Examiner's Answer mailed July 14, 2003, the Examiner newly presented and referenced two color coded copies of Fig. 3 of the Fehres '962 patent allegedly to support § 102 rejections. The Examiner also newly presented a color coded copy of Fig. 1 of the Hammes '934 patent allegedly to support a § 103 rejection.

The Examiner's reliance on color coded figures to demonstrate any alleged lack of patentability, as understood by Appellant, amounts to a "moving target." Appellant is entitled to an Answer that complies with 37 CFR §§ 1.104 and 1.193(a)(2).

The Examiner Appears To Have Arbitrarily Assigned Boundaries To The Cited References.

Even assuming *arguendo* that the Examiner's characterizations of the Fehres '962 patent and the Hammes '934 patent in the Answer are permitted under 37 CFR §§ 1.104 and 1.193(a)(2), the Examiner appears to arbitrarily assign boundaries to Fig. 3 of the Fehres '962 patent and Fig. 1 of the Hammes '934 patent in order to allegedly meet various limitations of Appellant's claims.

In an Interview Summary mailed December 3, 2001, the Examiner permitted Applicant to expressly delineate the boundaries of the first wall portion 27, second wall portion 29 and exterior rib 40 by presenting a Fig. 6a in the application. The Examiner

The concept of adding delineations to the cross section of Fig. 6 will *not* be considered new matter. The best way to do this is to submit another drawing figure and refer to it as a representation of the delineation of the first, second, third portions, etc. This figure should have the identical profile as the upper barrel edge but include only delineations . . . *The delineations will aid in* *consider the delineation of boundaries in a reference?*

providing a reference in describing the structure of the upper barrel edge so that the claims will be easier to understand and clearer in meaning.

(Interview Summary, December 3, 2001, continuation sheet) (Emphasis added). As shown in Fig. 6a, the second wall portion 29 constitutes that portion of the upper barrel edge 28 that is above an uppermost portion of the rib 40. Also, the first wall portion 27 constitutes that portion of the upper barrel edge 28 that is: (a) above a level of the radially innermost portion of the barrel's upper sidewall, (b) below the second wall portion 29 and (c) radially inward of the rib 40 to which first wall portion 27 is connected.

The Examiner's Answer, as understood by Appellant, appears to advance a claim construction that is clearly inconsistent with Fig. 6a of the application. The Fehres '962 patent is understood to be silent at least with respect ***a rib projecting radially outwardly beyond an outward extent of the first and second portions***, as recited in Appellant's independent claims 3, 4, 18 and 19. Furthermore, the Fehres '962 patent is understood to be silent at least with respect to ***a rib extending radially outwardly beyond an outward extent of said first and second chime walls***, as recited in Appellant's independent claims 5 and 10. The Examiner alleges "[t]here is no limitation that states that the exterior rib projects radially outwardly of every other part or portion of the upper barrel edge or that the exterior rib is the only outwardly projecting portion." (Examiner's Answer, page 7). But with Appellant's delineation of boundaries in Fig. 6a, Appellant respectfully submits that the Examiner's interpretation is unduly broad.

With respect to the Hammes '934 patent, this reference is understood to be silent at least with respect to ***an inner edge (27a) of the first portion (27) extending radially inward of the entire second portion (29)***, and ***a rib projecting radially outwardly beyond an outward extent of the first and second portions***, as recited in Appellant's independent claims 3 and 18. The Examiner advances a claim construction that relies on "color coded Fig. 3" (corresponding to Fig. 1 of the Hammes '934 patent) and again clearly fails to follow the delineations of Fig. 6a. Appellant submits that this interpretation by the Examiner also is unduly broad.

C. The Fehres '962 Patent Does Not Disclose a Drum With the Rib of Claim 15.

The Examiner's Answer states "[i]t seems that appellant may deem that the top surface of Fehres is substantially parallel to the bottom surface and therefore, no modification of Fehres is necessary." (Examiner's Answer, pages 8-9). In short, Appellant draws no such conclusion. Moreover, the Examiner rejected claim 15 under 35 U.S.C. § 103(a) in view of a combination of references, not a single reference. It is Appellant's

position that the Examiner's rejection of claim 15 simply fails to demonstrate *many* limitations in the claims, including, *inter alia*, that "said rib has a top surface substantially parallel to said bottom surface."

CONCLUSION

The Examiner's Answer concedes: "Appellant argues that in general the disclosed upper rim structure of the present invention is different than the disclosed upper rim structure of Fehres and of Hammes. The Examiner agrees with this statement and notes that differences definitely exist." (Examiner's Answer, page 7). Appellant respectfully submits that the features and elements recited in claims 3-23 are not disclosed, taught, or suggested by the Fehres '962 patent or the Hammes '934 patent, and the final rejections of claims 3-23 are in error and should be reversed.

No fee is believed to be due for this submission. Should any fees be required, however, please charge such fees to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Date: September 15, 2003

Respectfully Submitted,

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